

Reeves so characters on the display could be selected by a user.” Applicants respectfully disagree.

In order to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (citations omitted). In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combination(s). See M.P.E.P. §§ 2142 and 2143.01; see also *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); see also *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the modification of a single reference, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

There is no showing of any objective teaching to combine Reeves and Marks. The Office action merely states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teaching of Marks *et al.* into Reeves so characters on the display could be selected by a user.” This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these two references. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination.

Even assuming, *arguendo*, that a proper motivation to combine exists for the Examiner's proposed combination, Reeves taken in combination with Marks does not teach or suggest "an input selection mechanism for permitting a user to operate said input device in a character selection mode or a cursor movement mode" as recited in claim 93. Contrary to the Examiner's contention, Marks does not teach or suggest this limitation. Marks provides a pointing system for controlling a cursor on a computer display device that includes a single control actuator that ordinarily controls movement of the cursor on the display device and also detects if an applied cursor force matches a predetermined tap signature. Marks, abstract. If the applied force substantially matches the predetermined tap signature, the system responds to the applied force by initiating one or more "display actions" rather than by moving the display cursor. *Id.* Marks' "display action" mode is not identical nor similar to the claimed "character selection mode." For example, Marks specifies that a "display action" can be the act of toggling between open operating windows or executing a function such as one defined by the user or one associated with a typical keyboard function key. *See* Marks col. 6, line 63 to col. 7, line 12. Nowhere in Marks does it teach or suggest that Marks's system and particularly, the single control actuator provided therein, operates in a character selection mode to enable the selection of characters from, say, a character presentation graphic as described throughout Applicants' specification.

Dependent claim 99 further recites "a second input device adapted for the other hand of the user." Applicants maintain that Reeves clearly does not teach or suggest this limitation as the Examiner otherwise contends. Applicants submit that the Examiner's apparent justification in Reeves (*e.g.*, Fig. 1 and col. 1, lines 5-47) makes no reference to the use two joysticks, one of which is adapted for the other hand of the user. Marks fails to cure such a deficiency.

Dependent claim 100 further recites "wherein said base portion is movable on the surface upon which it is placed and said changes in position are of the entire base portion relative to its position prior to moving." Applicants maintain that Reeves clearly does not teach or suggest this limitation as the Examiner otherwise contends. Reeves teaches a joystick 20 comprising a handle 22 and a base 28. Reeves, col. 4, ll. 17-20. The handle 22 is moved relative to the base 28. *Id.* at col. 4, ll. 24-30. Reeves fails to teach that the base 28 is movable on a surface upon which it is placed as claimed. Marks fails to cure such a deficiency.

Applicants submit that claims 94-98, 101, 102, and 104 are patentable over the cited prior art at least because they depend from independent claim 93.

2. Claim 105 And Claims Dependent Therefrom

In regard to independent claim 105, the Examiner apparently asserts that Reeves discloses all of the recited claim limitations. Office Action at page 5. Applicants respectfully disagree.

Reeves, either taken alone or in combination with Marks, fails to teach or suggest “wherein said four primary keys are located in a substantially horizontal plane” as recited in claim 105. Reeves discloses a joystick controller 20 that includes a plurality of switches 30 as well as a hat switch controller 32 that is operable by a user’s thumb. Reeves, col. 4, lines 17-22 and Fig. 1. Referring to Fig. 1 of Reeves, it is clearly evident that any combination of the switches 30 and/or controller 32 is not located in a substantially horizontal plane. To infer otherwise completely disregards Reeves joystick configuration wherein finger buttons are provided in one or more vertical planes.

Applicants submit that claims 106-115 are patentable over the cited prior art at least because they depend from independent claim 105.

3. Claim 116 And Claims Dependent Therefrom

In regard to independent claim 116, the Examiner asserts that Reeves discloses all of the recited claim limitations except “a character selection graphic displayed on the display, the character selection graphic comprising a plurality of character selection icons, each of the icons corresponding to a character, wherein the character selection icons are selected by moving or positioning the top surface relative to the base portion and selectively engaging one of the four primary keys.” Office Action, page 9. In an attempt to cure such a deficiency, Marks is relied upon as allegedly disclosing such a character selection graphic and the Examiner thereby contends that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teaching of Marks *et al.* into Reeves so characters on the display could be selected by a user.” Applicants respectfully disagree.

There is no showing of any objective teaching to combine Reeves and Marks. As with the purported grounds for rejecting claim 93, the Office action merely states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teaching of Marks *et al.* into Reeves so characters on the display could be selected by a user.” This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these two references. There is

no showing that either of the applied references, or any other prior art, even remotely suggests such a combination.

Even assuming, *arguendo*, that a proper motivation to combine exists for the Examiner's proposed combination, Reeves taken in combination with Marks does not teach or suggest "a character selection graphic" as recited in claim 116. Contrary to the Examiner's interpretation, Marks also does not teach or suggest this limitation. As remarked above with respect to claim 93, Marks provides a pointing system for controlling a cursor on a computer display device or for actuating one or more "display actions." A display action is taught to be either the toggling among operating windows or the execution of a function, either user-defined or that associated with an ordinary keyboard function key. Marks does not teach or suggest a character presentation graphic or the use thereof. Rather, Marks explicitly provides a keyboard 14 as the character input device. Applicants submit that the existence of a character selection graphic in conjunction with the claimed input device eliminates the need for a keyboard in a computer system.

Applicants submit that claims 117-121 are patentable over the cited prior art at least because they depend from independent claim 116.

Applicants respectfully submit that the instant rejection is unsustainable and request the Examiner to withdraw the rejection of claims 93-102 and 104-121.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. Should the Examiner believe anything further is desirable in order to place the Application in even better condition for allowance, the Examiner is invited to contact the Applicants' undersigned representative.

No fee is believed to be required for the entry of this Reply. Nonetheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Reply or to maintain the present application as pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

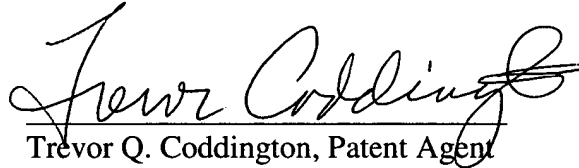
Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: October 21, 2003

Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

By:



Trevor Q. Coddington, Patent Agent
Registration No. 46,633

for: Rodger L. Tate
Registration No. 27,399